

## **REMARKS**

### **Status of Claims:**

Claims 1-19 were pending in the application. Claim 2 is hereby cancelled without prejudice or disclaimer of subject matter contained therein. Claims 1 and 3-19 are now pending. Each of the pending claims defines an invention that is novel and unobvious over the cited art. Favorable consideration of this case is respectfully requested.

### **Disclosure Supporting the Instant Amendment:**

Claims 1, 13 and 15-17 are hereby amended to indicate that the urethane is "synthesized from at least one polyester polyol and at least one aliphatic diisocyanate." Support for the recitation is present in the original disclosure at, for example paragraphs [0015], [0018], and [0034].

### **Rejection Under 35 U.S.C. § 102(b), or in the Alternative, Under 35 U.S.C. § 103(a):**

Claims 1 and 6-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, as obvious over Nerad (5,641,426).

Rejection under 35 U.S.C. § 102 requires the prior art disclose each and every recitation of the claimed invention.<sup>1</sup> In determining anticipation, no claim recitation may be ignored.<sup>2</sup> Anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims.<sup>3</sup> There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. §

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<sup>1</sup> See MPEP § 706.02.

<sup>2</sup> See *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

<sup>3</sup> See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

102.<sup>4</sup> The evidentiary record fails to teach a vinyl-terminated urethane synthesized from at least one polyester polyol and at least one aliphatic diisocyanate.

The original disclosure at paragraphs [0015], [0018], and [0034] teaches that the reaction of a vinyl-terminated urethane and a thiolene may be endogenously photoinitiated where the urethane is aliphatic. Nerad discloses vinyl-functional urethanes, but Nerad does not disclose that the urethanes must be aliphatic. Claims 1, 13, and 15-17 have been amended to recite the urethane is synthesized from at least one polyester polyol and at least one aliphatic diisocyanate.

**Rejections Under 35 U.S.C. § 103(a):**

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nerad in view of Hagstrom (5,578,693),

To establish *prima facie* obviousness of a claimed invention, all the claim recitations must be taught or suggested by the prior art. *In re Royka*.<sup>5</sup> All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*.<sup>6</sup> (MPEP § 2143.03). When evaluating the scope of a claim, every recitation in the claim must be considered. See e.g. *In re Ochiai*.<sup>7</sup> (MPEP § 2144.08). The evidentiary record fails to teach each recitation of the present invention.

As discussed above, Nerad fails to teach aliphatic diisocyanates. Hagstrom does not supply the required teaching because Hagstrom specifically teaches aromatic diisocyanates (col. 3, lines 15-20).

**Conclusion:**

In view of the above, consideration and allowance are respectfully solicited.

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<sup>4</sup> See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

<sup>5</sup> *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>6</sup> *In re Wilson*, 424 F.2d 1382, 165 USPQ 496 (CCPA 1970).

<sup>7</sup> *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).

Accordingly, it is respectfully requested that the foregoing amendments be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

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Respectfully submitted,

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